

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

NEONODE SMARTPHONE LLC,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO. LTD.,
and SAMSUNG ELECTRONICS
AMERICA, INC.,

Defendants.

Civil Action No. 6:20-cv-00507-ADA

JURY TRIAL DEMANDED

**DEFENDANTS SAMSUNG ELECTRONICS CO. LTD. AND SAMSUNG
ELECTRONICS AMERICA, INC.'S UNOPPOSED MOTION FOR ISSUANCE OF
LETTER OF REQUEST TO EXAMINE PERSONS, INSPECT DOCUMENTS AND
INSPECT PROPERTY PURSUANT TO THE HAGUE CONVENTION ON THE
TAKING OF EVIDENCE ABROAD IN CIVIL OR COMMERCIAL MATTERS**

Defendants Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.'s ("Defendants" or "Samsung") hereby move for issuance of a Letter of Request for International Judicial Assistance ("Letter of Request") to compel the attendance at deposition of, production of documents and physical evidence by, two witnesses residing in Sweden: Magnus Goertz, the inventor named on the two Patents-in-Suit, and Björn Thomas Eriksson ("Thomas Eriksson"), the co-founder (with Mr. Goertz) of Neonode, Inc.

Samsung requests issuance of the Letter of Request pursuant to Rule 28(b) of the Federal Rules of Civil Procedure, and in conformity with the Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters, T.I.A.S. 7444, 23 U.S.T. 2555, reprinted in 28 U.S.C. § 1781 ("Hague Evidence Convention"), which is in force between the United States and Sweden. Issuance of the Letters of Request under the Hague Evidence Convention is a proper method for collecting documents and the taking of testimony of persons

residing abroad. Fed. R. Civ. P. 28(b); *Pain v. United Tech. Corp.*, 637 F.2d 775, 788-90 (D.C. Cir. 1980), *cert. denied*, 454 U.S. 1128 (1991).

A proposed Letter of Request is attached hereto as Exhibit A, following the model set out in the Hague Evidence Convention.

STATEMENT OF THE CASE

Samsung brings the present application because it believes that Magnus Goertz and Thomas Eriksson possess information relevant to this litigation involving both Neonode and Samsung. Mr. Goertz is the soled named inventor on the patents at issue in this litigation – U.S. Patent Nos. 8,095,879 (“the ‘879 Patent”) and 8,812,993 (“the ‘993 Patent;” collectively, “the Patents-in-Suit”). Plaintiff Neonode has alleged Mr. Goertz and Mr. Eriksson are knowledgeable regarding the development of the Neno user interface and the Neonode mobile phone, which Plaintiff Neonode alleges to be relevant to the Patents-in-Suit.

Although the Court has stayed this action pending the resolution of Apple’s Motion to Transfer Venue to the Northern District of California in the *Neonode v. Apple* case (Case No. 6:20-cv-00505 (*see* Dkt. No. 36), there is no reason to delay taking this discovery. The Court’s OGP – Patent Case, v. 3.2, provides that “the Court will permit limited discovery by agreement of the parties, or upon request, where exceptional circumstances warrant. For example, if discovery outside the United States is contemplated, the Court will be inclined to allow such discovery to commence before the Markman hearing.” Because Mr. Goertz and Mr. Eriksson are third parties that reside in Sweden, this is exactly such discovery. Furthermore, this Court specifically authorized taking Mr. Goertz’s deposition prior to Markman because of his unique knowledge about alleged conception and reduction to practice of the claimed inventions in the Patents-in-Suit. *See* Dkt. No. 28 at 16-19. Finally, Neonode Smartphone’s Motion for Issuance of Letter of Request

to Examine Persons, Inspect Documents and Inspect Property Pursuant to the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (Dkt. No. 39) indicates that it too believes that discovery related to Mr. Goertz and Mr. Eriksson should occur before the *Markman* hearing in this case.

PROCEDURE

Samsung respectfully asks this Court to issue a Letter of Request to examine Mr. Goertz and Mr. Eriksson and inspect documents as set forth in Exhibit A to the Request for International Judicial Assistance below in order to fully develop its claims and defenses in this action. The evidence sought in the Letter of Request cannot be obtained by other means.

In the event the Court grants the instant application, Samsung requests that the Court execute the Letter of Request with the Court's signature and seal, and provide an original of the executed Letter of Request to Samsung's undersigned counsel. Samsung will then transmit the executed Letter of Request to the Swedish authority for execution.

Accordingly, Samsung requests that the Court sign under seal and issue the attached Letters of Request to the appropriate authority in conformity with the Hague Evidence Convention, including requests to compel the attendance at deposition and production of documents by Magnus Goertz and Björn Thomas Eriksson in the form as attached as Exhibit A.

Dated: April 19, 2021

Respectfully submitted,

/s/ John M. Guaragna

John M. Guaragna

Texas Bar No 24043308

DLA PIPER LLP (US)

401 Congress Avenue, Suite 2500

Austin, TX 78701-3799

Tel: 512.457.7125

Fax: 512.457.7001

john.guaragna@dlapiper.com

Mark D. Fowler (*Pro hac vice*)
Bar No. 124235
mark.fowler@dlapiper.com
Erik Fuehrer (*Pro hac vice*)
Bar No. 252578
Erik.fuehrer@dlapiper.com
DLA PIPER LLP (US)
2000 University Avenue
East Palo Alto, CA 94303-2214
Tel: 650.833.2000
Fax: 650.833.2001

Tiffany Miller (*Pro hac vice*)
Tiffany.miller@dlapiper.com
Susan Acquista (*Pro hac vice*)
Susan.acquista@dlapiper.com
DLA PIPER LLP (US)
401 B Street, Suite 1700
San Diego, CA 92101-4297
Tel: 619.699.2700
Fax: 619.699.2701

Benjamin Mueller (*Pro hac vice*)
Benjamin.mueller@dlapiper.com
DLA PIPER LLP (US)
444 West Lake Street, Suite 900
Chicago, IL 60606-0089
Tel: 312.368.4000
Fax: 312.236.7516

ATTORNEY FOR SAMSUNG ELECTRONICS
CO. LTD, and SAMSUNG ELECTRONICS

CERTIFICATE OF SERVICE

The undersigned certifies that on this 19th day of April 2021, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(b)(1). Any other counsel of record will be served by a facsimile transmission and/or first class mail.

/s/ John M. Guaragna
John M. Guaragna